

## REMARKS

The Notice of Not Fully Responsive Reply dated October 18, 2006, and the Office Action dated March 24, 2006 (hereinafter the “Office Action), have been received and considered. Reconsideration of the outstanding rejections is respectfully requested based on the following remarks.

### **Withdrawal of Objection to Drawings**

Applicant notes that at page 2 of the Notice the objection to the drawings at page 3 of the Office Action requesting additional drawings has been withdrawn. Although Applicant believes that the new Figures 4-12 submitted in the Response to Office Action of July 24, 2006 do not introduce new matter, in an effort to advance the present application, Applicant hereby withdraws and cancels, without prejudice or disclaimer, the previously submitted Figures 4-12. The specification has been amended to reflect the withdrawal and cancellation of the previously submitted Figures 4-12.

### **Double Patenting**

At page 2 of the Office Action claims 1-46 are provisionally rejected on the ground of non-statutory double patenting over claims 1-64 of copending Application Number 10/869,165. Although Applicant traverses with the rejection, in light of the fact that the rejection is provisional, Applicant declines to file a terminal disclaimer at this time. Applicant will revisit the filing of a terminal disclaimer when the scope of the claims of the copending application is finalized.

### **Obviousness Rejection of Claims 1-4, 6, 11-14, 16-28 and 41-43**

At page 4 of the Office Action, claims 1-4, 6, 11-14, 16-28 and 41-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Endo et al. (U.S. Patent No. 6,615,303) in view of Watanabe et al. (U.S. Patent No. 6,763,458). This rejection is hereby respectfully traversed.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” MPEP § 2143. Further, a prior art reference must be considered

in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert denied, 469 U.S. 851 (1984). In this case there is no motivation to combine Endo and Watanabe because such combination would render Endo unsuitable for its intended purpose. “If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP, § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

According to Endo

An object of the present invention to provide a scheme to making the input and output device provided in a computer in common for a plurality of operating system, in a multiple operating system control unit *operating a plurality of mutually distinct operating systems on one computer system*.

In order to accomplish the above mentioned object, According [sic] to the first invention, a computer system including a plurality of operating systems, and an OS switching means for switching a plurality of operating systems, characterized in that said OS switching means makes reference to a preferential interrupt table on the basis of an interrupt factor for switching to corresponding operating system and calls interrupt processing means incorporated in said operating system for making the input and output device provided in the computer system in common for a plurality of operating systems.

*Endo*, col. 2, line 65 – col. 3, line 13 (emphasis added). Thus, the intended purpose of Endo is to provide a scheme to allow input and output devices to be operated by a computer that is running multiple operating systems concurrently. *See Id.*, col. 5, lines 33 –38 (“In the shown embodiment, discussion will be given for the case where two operating systems 116 and 117 are present in the computer system. The operating systems 116 and 117 execute tasks 110 to 115 using memory assigned for each operating system and a resource of the processor”).

In contrast to Endo, the system of Watanabe executes only a single operating system at a time. According to Watanabe

The invention provides apparatus, system, computer program, and method that provide multiple operating system support and a fast startup capability in a computer or information appliance device. More particularly it permits a user to *select and execute one of a plurality of alternative operating systems available on*

the device at the time of powering on the device and where data generated by an application program executing within one of the plurality of operating systems is available to a different application program executing within a different operating system on the same device.

*Watanabe*, col. 8, lines 1- 13 (emphasis added); see also col. 25, lines 22-28 (“FIG. 6A shows a first exemplary switching device 320 for generating boot control bit values 321 at an input/output port 322 that can be read by a processor 323 within a computer or information appliance 324 during its boot operation and thereby control *which of a plurality of available operating systems* is booted by the computer.” (emphasis added)); col. 25, lines 48-53 (“FIG. 7 is a diagrammatic illustration showing an even more general device or logic element 336 that generates a binary boot indicator flag (or flags) 337 as a boot control indicator that can be read by a processor 323 within a computer or information appliance during its boot operation and thereby control *which of two (or more) operating systems* is booted.” (emphasis added)).

Thus, if the system of Watanabe, which selects and executes *only one* of a plurality of operating systems at a time, were combined with the system of Endo it would render Endo unsatisfactory for its intended purpose of providing a scheme to allow input and output devices to be operated by a computer that is running multiple operating systems *concurrently*. Concurrent running of operating systems, as taught by Endo, is diametrically opposed to executing one operating system at a time as taught by Watanabe. Accordingly, one of ordinary skill in the art would find no motivation to combine Endo and Watanabe as each reference teaches away from the essential feature of the other.

Further, in order to combine references for an obviousness rejection, there must be a reasonable expectation of success which is round in the prior art, not in an applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). There is no reasonable expectation that a combination of Endo and Watanabe would be a success, because Endo teaches concurrent execution of operating systems, and Watanabe teaches execution of a single operating system at a time. Accordingly, Endo and Watanabe cannot be combined for purposes of an obviousness rejection.

In view of the foregoing, Applicant respectfully submits that the obviousness rejection of claims 1-4, 6, 11-14, 16-28 and 41-43 is improper. Withdrawal of the rejection and reconsideration of the claims is respectfully requested.

#### **Obviousness Rejection of Claims 5, 7-10, 15, 29-40 and 44-46**

At page 8 of the Office Action, claims 5, 7-10, 15, 29-40 and 44-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Endo and Watanabe in view of “Official Notice”. This rejection is hereby respectfully traversed. As explained above, there is no motivation to combine Endo and Watanabe, and therefore their combination cannot form the basis of an obviousness rejection.

In view of the foregoing, Applicant respectfully submits that the obviousness rejection of claims 15, 7-10, 15, 29-40 and 44-46 is improper. Withdrawal of the rejection and reconsideration of the claims is respectfully requested.

#### **Obviousness Rejection of Claims 1-4, 6, 11-28 and 41-43**

At page 13 of the Office Action, claims 1-4, 6, 11-28 and 41-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Endo et al. in view of Ginter et al. (U. S. Patent No. 6,363,488). This rejection is hereby respectfully traversed.

As explained above, in order for the combination of two or more references to provide the basis for an obviousness rejection, there must be a motivation to combine the references. However, there is no motivation to combine Endo and Ginter, because such combination would render Endo unsuitable for its intended purpose. As explained, the intended purpose of Endo is “to provide a scheme to making the input and output device provided in a computer in common for a plurality of operating system, in a multiple operating system control unit *operating a plurality of mutually distinct operating systems on one computer system.*” *Endo*, col. 2, line 65 – col. 3, line 2 (emphasis added).

However, Ginter discloses a virtual distribution environment (VDE) to enforce a secure chain of handling among distributed electronic devices. *Ginter*, Abstract. As part of the VDE, Ginter discloses a Rights Operating System (ROS) that includes “operating system layers for desktops (e.g., DOS, Windows, Macintosh); device drivers and operating system interfaces for

network services (e.g., Unix and Netware); and dedicated component drivers for ‘low end’ set tops.” *Id.*, col. 73, lines 62-66. Thus, the Ginter system clearly discloses using multiple operating systems on **multiple systems**, such as multiple desktop computer systems. Accordingly, combining Ginter with Endo would render Endo unsuitable for its intended purpose of providing a scheme to allow input and output devices to be operated by a *single computer system* that is running multiple operating systems concurrently. Accordingly, there is no motivation to combine Ginter and Endo.

In view of the foregoing, Applicant respectfully submits that the obviousness rejection of claims 1-4, 6, 11-28 and 41-43 is improper. Withdrawal of the rejection and reconsideration of the claims is respectfully requested.

#### **Obviousness Rejection of Claims 5,7-10, 29-40 and 44-46**

At page 17 of the Office Action, claims 5, 7-10, 29-40 and 44-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Endo and Ginter in view of “Official Notice”. This rejection is hereby respectfully traversed. As explained above there is no motivation to combine Endo and Ginter, and therefore their combination cannot form the basis of an obviousness rejection. Accordingly, Applicant respectfully submits that the obviousness rejection of claims 5, 7-10, 29-40 and 44-46 is improper. Withdrawal of the rejection and reconsideration of the claims is respectfully requested.

#### **Conclusion**

The Applicants respectfully submit that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

The Applicants believe no additional fees are due, but if the Commissioner believes additional fees are due, the Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-0441.

Respectfully submitted,

/Adam D. Sheehan/

Adam D. Sheehan; Reg. No. 42,146

LARSON NEWMAN ABEL POLANSKY & WHITE, LLP

5914 West Courtyard Dr., Suite 200

Austin, Texas 78730

(512) 439-7100 (phone)

(512) 439-7199 (fax)

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